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WILLIAM E. SCHIESSER
IBM CORPORATION / IP LAW DEPT.. IQ0A/040-3
1701 NORTH STREET
ENDICOT, NY 13760

EXAMINER

SHAFFER, ERIC T

ART UNIT PAPER NUMBER

3623

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/524,366

Applicant(s)

GRECHUS ET AL.

Examiner

Eric T. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 6) ☐ Other:

DETAILED ACTION

1. This communication is in response to the amendments filed May 12, 2003.

Summary Of Instant Office Action

2. Applicant's arguments, filed May 12, 2003, concerning claims 1 – 10 in the Office Action mailed February 7, 2003, have been considered and deemed unpersuasive.
3. Claims 3 and 4 have been cancelled by the applicant and the applicant has added no new claim. Claims 1, 2 and 5 – 10 are pending and are prosecuted in the response set out below. Only one of the rejections in the Office Action mailed out on February 7, 2003, namely the rejection under 35 USC § 112 has been withdrawn.

Claim Objections

4. Claims 1 and 6 – 9 are objected to because of the following informalities: Applicant's use of the term "greatest economic benefit by recovering largest revenue" is vague and indefinite. Term fails to consider that if the cost to recover a part exceeds the revenue generated from selling said part, then said part will be recovered at a loss, thus producing no profit and no economic benefit. Appropriate correction is required.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2 and 5 - 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 5,965,858) in view of Graff (US 5,802,501).

As per claims 1 and 6 – 9, Suzuki et al teaches a method and system of optimally demanufacturing a product to provide greatest economic benefit, comprising the steps of:

providing a product for demanufacturing, said product having a plurality of parts, wherein each of said parts comprises one or more commodities (column 7, lines 23 – 25, “the discarded televisions to be reused as the restored material are pulverized or fragmented in the recycling factories whereupon some of the fragmented materials will be supplied to the manufacturer”);

collecting one or more resale prices for said product or parts (column 14, lines 32 – 35, “Market Information, details of which, i.e., used article information, are illustrated in FIG. 30. Contents: information of market prices of used articles, part demand information, etc.”

collecting one or more resale prices for one or more of said parts respectively (column 42, lines 53 – 55, “The purchase prices of the material dealers are recorded in the material/part-based recycle method database 37 on a material-by-material basis”).

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collecting one or more commodity prices for one or more of said commodities respectively (column 42, lines 53 – 55, “The purchase prices of the material dealers are recorded in the material/part-based recycle method database 37 on a material-by-material basis”);

Suzuki et al. does not explicitly teach the determination of the labor expenses of removing parts from computer products, however he does tabulate the “standard number of disassembling steps or processes involved (hours)” (column 35, lines 23 – 24).

entering said resale prices, said commodity prices (column 10, lines 26 – 28, “in the market information database, there are stored information concerning the market prices of the used articles”), and said labor expense (column 35, lines 23 - 24, “standard number of disassembling steps or processes involved hours, etc”) into a computer spreadsheet model;

Suzuki et al does not specifically mention creating a computer model that determines the highest revenue value of a commodity in order to determine which parts to remove and sell.

Graff teaches a computer model based device (column 11, lines 40 - 43, “ a LOTUS 123 program dedicated to the purpose of this invention”) for finding the highest commodity value of the removed parts or subcomponents of a property (column 3, lines 20 – 22, “it is frequently possible to sell the components of the property for more than the price of that property”) or a part (column 29, lines 58 – 60, “input data characterizing at least one of the two components decomposed from the property”) and for performing a separation that will “maximize profitability of the components” (column 6, lines 25 - 27).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to consider the revenue generated from recovered parts and the cost associated with removing said parts in determining which parts to disassemble and recycle from

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a larger property because this would prevent a recycler from recycling parts that were not cost effective to recover and would provide the highest profit to one in the recycling business.

7. As per claim 2, Suzuki et al teaches the method of claim 1, wherein said resale prices, said commodity prices, and said labor expense are provided from a database wherein said database is periodically updated (column 10, lines 31 – 40, “the market information database stores therein the market prices of the used articles for each of the types of the articles so that the market price information can be obtained when the restored article such as the restored televisions are to be recycled as the used article, as can be seen from FIG. 30. Besides, the information concerning the market prices of the used component parts of the article is also stored so that the market prices of the parts can be made available when they are to be recycled as the used parts”) and (column 8, lines 55 – 57, “the recycle method decision processor unit further includes a recycle method decision module which stores therein a recycle processing decision procedure”).

8. As per claim 5, Suzuki et al teaches a “spreadsheet model” (Figures 26 and 28 – 30).

9. As per claim 10, Graff teaches the computer program product, further comprising a database comprising said resale prices, said commodity prices, and said labor expense, and wherein said database is recorded on said medium (column 11, lines 40 - 43, “ a LOTUS 123 program dedicated to the purpose of this invention”).

Response to Amendments

10. Applicant’s arguments filed April 7, 2003 have been fully considered, but the same are not persuasive.

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a) Applicant argues that Graff (US 6,192,247) be withdrawn from consideration as applicant's invention was reduced to practice prior to August 14, 1998. Examiner hereby removes Graff (US 6,192,247) from consideration and replaces it with Graff (US 5,802,501) filed Jan. 12, 1994.

b) Applicant argues that Suzuki does not provide all the steps in the applicants invention. However Suzuki et al, in combination with the newer and earlier Graff prior art does teach all the steps of the applicant's invention.

c) Applicant argues that Suzuki does not optimally determine which of parts to remove from a product to provide maximum economic benefit by recovering the greatest economic benefit. However the new and earlier Graff prior art does in fact teach providing the greatest economic benefit by disassembling a larger property into component parts in order to "maximize profitability of the components" (column 6, lines 25 - 27). Since the applicant does not specify any type of product the invention is meant to demanufacturer; unlike the previous application which was specific to computer products; the claims are interpreted to include any and all types of properties and products that could be disassembled into smaller parts or components.

d) Applicant argues that Suzuki does not teach execution to optimally determine which parts to be removed to create the largest revenue. However the new and earlier Graff prior art does in fact teach optimally determine which parts to remove by disassembling a larger property into component parts in order to "maximize profitability of the components" (column 6, lines 25 - 27).

In light of the above stated facts, examiner respectfully states that applicant's arguments have been fully considered, deemed unpersuasive, and the rejections under the prior Office

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Action, mailed February 7, 2003, are maintained, along with the additional rejection of the new claim 9.

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Conclusion

11. No claims were allowed and all claims were rejected.
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Graff (US 5,802,501) – Later version of the art cited in the action.
Stanczyk et al. (US 5,532,928) – Waste accounting system
Embutsu et al. (US 5,699,525) – Waste recycling invention
Sato et al (US 6,305,548) – Industrial product recycling system
Bloom (US 5,080,291) – Automobile waste recycling device
Portarella (US 4,488,463) – Electronic part recycling device

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric Shaffer whose telephone number is (703) 305-5283. The Examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

Or faxed to:

(703) 746-7238	[After Final communications, labeled "Box AF"]
(703) 746-7239	[Official communications]
(703) 706-9124	[Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 7th floor receptionist.

ETS

June 19, 2003


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